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10/522,752	02/01/2005	Makoto Urushihara	263468US6PCT	9309

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
KHAN, ASHER R	
ART UNIT	**PAPER NUMBER**
2621	

NOTIFICATION DATE	DELIVERY MODE
03/12/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/522,752	URUSHIHARA ET AL.	
	Examiner	Art Unit	
	ASHER KHAN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/01/2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *4-7, 10-14 and 20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/13/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claim 1, 15 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.
>
> Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.
>
> … a signal does not fall within one of the four statutory classes of Sec. 101.
>
> … signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 15 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 15 and 16 are directed to a "computer readable medium". In the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and given the broadest reasonable interpretation, the scope of a "computer readable medium" covers a signal per se.

Allowable Subject Matter

1. Claims 4-7, 10-14 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 15, 17-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent 5,793,927 to Lane and in further view of U.S. Patent Pub. 2002/0054754 A1 to Kikuchi et al. "Kikuchi".

As to claims 1, 15 and 17, Yanagihara discloses an information processing apparatus comprising:

checking means for checking predetermined time information of content data recorded in a first format (Col. 4 lines 60-67);

setting means for setting, on the basis of said content data time information checked by said checking means, bit rates with which said content data is recorded from said information processing apparatus to a predetermined removable recording medium (Col. 5, lines 4-15;Col. 7, lines, 7-33); and

recording control means for converting the format of said content data from said first format to a second format and recording the converted content data to said recording medium with said bit rates set by said setting means (Fig. 8;Col. 4, lines 60-67, Col. 5, lines 1-15; Col. 9, lines 50-62).

Yanagihara does not expressly disclose controlling a content providing device to reproduce at a faster speed than a normal speed of the content providing device.

Lane disclose controlling a content providing device (Fig. 1, 100) to reproduce at a faster speed than a normal speed of the content providing device (Col. 10, lines 11-18).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara with the teachings of Lane. Motivation to combine would have been to provide time information by fast forwarding so that transcoding can be performed efficiently.

Yanagihara and Lane as modified do not expressly disclose the setting means selecting the bit rates such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity of a predetermined removable recording medium based on a comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium

Kikuchi discloses the setting means selecting the bit rates such that an amount of data to be stored (reserved recording time or capacity need for recording, 0051;0137) on the predetermined removable recording medium (information recording medium or disk, 0051;0137) is less than a capacity of a predetermined removable recording

medium based on a comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium (0051; 0105; 0137).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara and Lane as modified with the teachings of Temple. Motivation to combine would have been to record only if enough capacity for recording is available.

As to claims 2 and 18, Yanagihara, Lane and Kikuchi as modified disclose everything claimed as applied in claim 1 above. Yanagihara further wherein said checking means checks a recording time of said content data recorded in said first format as said time information (Col. 4, lines 60-67; Abstract).

As to claims 3 and 19, Yanagihara, Lane and Kikuchi as modified disclose everything claimed as applied in claim 1 above. Yanagihara further discloses wherein said content data is constituted by a moving image data and audio data corresponding thereto (Fig.1;Col. 1, lines 66-67, Col 2, lines 1-6); said setting means sets, as said bit rates, a first bit rate corresponding to said moving image data and a second bit rate corresponding to said audio data (Figs. 1,5; Col. 1 line 66-67, Col. 2, lines 1-6; Col. 5, lines 4-15;Col. 7, lines, 7-33); and

said recording control means executes control so as to record said moving image data of said content data in said first bit rate set by said setting means and record said audio data in said second bitrate set by said setting means (Fig. 8;Col. 4, lines 60-67, Col. 5, lines 1-15; Col. 9, lines 50-62).

As to claims 21, 22 and 23, Yanagihara, Lane and Kikuchi as modified disclose everything claimed as applied in claim 1 above. Kikuchi further discloses wherein the setting means selects a value for the bit rate of audio data and selects a value for the bit rate of video data by computing a maximum possible bit rate based on the capacity of the predetermined removable storage medium and the value for the bit rate of the audio data (0070;0076;.0131-0132).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara and Lane with the teachings of Kikuchi. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent 5,793,927 to Lane, in view of U.S. Patent Pub. 2002/0054754 A1 to Kikuchi et al. "Kikuchi" and in further view of U.S. Patent Pub. 2003/0194008 A1 to Acharya et al "Acharya"

As to claim 8, Yanagihara, Lane and Kikuchi as modified disclose everything claimed as applied in claim 1 above but Yanagihara, Lane and Kikuchi as modified do not expressly disclose wherein said first format is a format of a digital video tape recorder and said second format is a format specified by the DVD standard.

Acharya discloses wherein said first format is a format of a digital video tape recorder and said second format is a format specified by the DVD standard (Fig. 3; 0001-0002; 0004)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara, Land and Temple as modified with the teachings of Acharya. Motivation to combine would have been to convert digital video tape recording to DVD recording.

7. Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent 5,793,927 to Lane, in view of U.S. Patent Pub. 2002/0054754 A1 to Kikuchi et al. "Kikuchi" in view of Japanese document JP 08-031044 to Mimura Yoshiaki "Mimura" and in further view of U.S. Patent Pub. 2006/0010136 A1 to Deangelo.

As to claims 9 and 16, Yanagihara, Lane and Kikuchi as modified disclose everything claimed as applied in claim 1 above. Yanagihara further discloses further comprising: storage means for storing said content data, said recording control means (System is a recorder; Col. 3, lines 42 -45; Col. 4 lines 45 -49).

Yanagihara, Lane and Kikuchi as modified do not expressly disclose computation means for computing a free capacity of said storage means;
acquisition means for dividing said content data into a plurality of data sections on the basis of said free capacity of said storage means computed by said computation means, acquiring a predetermined first data section among said plurality of data sections, and storing said acquired predetermined first data section into said storage

means; conversion means for converting said format of said first data section acquired by said acquisition means from said first format to a second format, generating a second data section smaller in data amount than said first data section, and storing the generated second data section into said storage means;

deletion means for deleting, when said generated second data section obtained by converting said format of said first data section by said conversion means has been stored in said storage means, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data; and

recording medium recording control means for, if said content data has all been acquired in said acquisition means, converted into said second format in said conversion means, and stored in said storage device, recording the content data of said second format to said recording medium at said bit rate set by said setting means.

Mimura discloses computation means for computing a free capacity of said storage means (0007-0008; measuring of residue of 2nd magnetic tape);

acquisition means for dividing said content data into a plurality of data sections on the basis of said free capacity of said storage means computed by said computation means, acquiring a predetermined first data section among said plurality of data sections, and storing said acquired predetermined first data section into said storage means (0007-0008)

conversion means for converting said format of said first data section acquired by said acquisition means from said first format to a second format (Long time to standard or

standard to long; Claim 3), generating a second data section smaller in data amount than said first data section, and storing the generated second data section into said storage means (claim 1; Long time to standard time);
and recording medium recording control means for, if said content data has all been acquired in said acquisition means, converted into said second format in said conversion means, and stored in said storage device, recording the content data of said second format to said recording medium(0007-0012).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara, Lane and Kikuchi as modified with the teachings of Mimura. Motivation to combine would have been to transfer data from one medium to other in a set portion so that all the media could be transferred from one medium to other.

Yanagihara, Lane, Temple and Mimura as modified do not expressly disclose deletion means for deleting, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data.

Deangelo disclose deletion means for deleting, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data (0140)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara, Lane, Kikuchi and Mimura as modified with the

teachings of Iwatsu. Motivation to combine would to delete what has been recorded already and copying or recording new contents into a storage.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks- Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/A. K./
Examiner, Art Unit 2621